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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,921	01/14/2004	Rathinam Jothi Mahalingam	136382-2	5122

43248 7590 10/31/2007
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EXAMINER

QAZI, SABIHA NAIM

ART UNIT	PAPER NUMBER
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1616

MAIL DATE	DELIVERY MODE
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10/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/757,921

Applicant(s)

MAHALINGAM ET AL.

Examiner

Sabiha Qazi

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32, 35 and 39-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32, 35 and 39-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Final Office Action

Claims 32, 35, and 39-67 are pending. No claim is allowed at this time. Claims 1-31, 33, 34, 36-38 are canceled. New claims 39-67 are added, 32 and 35 are amended. Amendments are entered.

Summary of this Office Action Friday, October 26, 2007

1. Information Disclosure Statement
2. Copending Applications
3. Specification
4. 35 USC § 112 ---Written Description Rejection
5. 35 USC § 112 ---Second Paragraph Rejection
6. 35 USC § 102 (e) Rejection
7. Conclusion
8. Communication

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Copending Applications

Applicants must bring to the attention of the examiner, or other Office official involved with the examination of a particular application, information within their knowledge as to other copending United States applications, which are "material to patentability" of the application in question. MPEP 2001.06(b). See *Dayco Products Inc. v. Total Containment Inc.*, 66 USPQ2d 1801 (CA FC 2003).

Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

35 USC § 112 --- First Paragraph Written Description Rejection

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 32, 35 and 39-67 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In the present case Applicant has no possession of the claimed subject matter.

Claims 32, 35 and 39-67 are drawn to a polycarbonates comprising structural units derived from the hydroquinone compound. There is no structure or average molecular weight such as range in Daltons and end chain structure. Further there is guidance or teaching about claimed polycarbonates. Final product has no limitation. For example polycarbonates are commonly describe as containing at least a) a weight average molecular weight of between 10,000 and 100,000 Dalton; (b) less than 1% of chain ends bearing free hydroxy groups, less than 100 parts per million Fries product; (c) less than 1 mole percent of internal ester carbonate linkages relative to total number of moles of dihydroxy aromatic compound reacted; and (d) less than 1 mole percent of terminal hydroxy ester groups relative to total number of moles of dihydroxy aromatic

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compound reacted. In the present case "polycarbonate" may include any polycarbonate. Specification does not describe the claimed subject matter.

The written description requirement prevents applications from using the amendment process to update the disclosure in their disclosures (claims or specification) during the pendency before the patent office. Otherwise applicants could add new matter to their disclosures and date them back to their original filing date, thus defeating an accurate accounting of the priority of the invention. See 35 USC 132.

The function of description requirement is to ensure that the inventor had possession, as of filing date of the application relied on, the specific subject matter claimed by him.

See *Genetech*, 108 F 3d 1361, 1365 (Fed. Cir. at 1366, 78, 1999).

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to one skilled in the art that the inventor had the possession at the time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claimed language. See *In re Kaslow*, 707 F 2d 1366, 1375 (Fed. Cir. 1983).

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Therefore, Applicant has no possession of the invention of the subject matter as claimed at the time of filing the application. Applicant is kindly requested to explain the issue.

See MPEP 2163.06.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 32, 35 and 39-67 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Following reasons apply:

Claims are drawn to polycarbonates comprising structural units derived from a hydroquinone compound. Claims are open ended because there is no average molecular weight or any structure, which can possibly tell about the said polycarbonate such as groups at the end terminals. (See above). Furthermore, how polycarbonate was prepared is missing.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

Claims 32, 35 and 39-67 rejected under 35 U.S.C. 102(e) as being anticipated by McCloskey et al.

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

See [0032] where the dihydroxy aromatic compounds used according to the method of the invention include at least one dihydroxy aromatic compound selected from the group consisting of resorcinol, methylresorcinol, hydroquinone, and methylhydroquinone. The product polycarbonate prepared according to the method of the present invention thus comprises repeat units derived from at least one member of the group consisting of resorcinol, methylresorcinol, hydroquinone, and methylhydroquinone. The present invention provides a method for the preparation of homopolycarbonates, and polycarbonates comprising repeat units derived from two or more dihydroxy aromatic compounds.

[0033] The polycarbonates prepared according to the method of the present invention may further comprise repeat units derived from a variety of dihydroxy aromatic compounds in addition to resorcinol, methylresorcinol, hydroquinone, and methylhydroquinone. For example, polycarbonates prepared according to the method of

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the present invention may also comprise repeat units derived from dihydroxy aromatic compounds selected from the group consisting of bisphenols.

See specially the following claims:

4. A method according to claim 1 wherein said product polycarbonate comprises repeat units derived from hydroquinone.

5. A method according to claim 1 wherein said product polycarbonate comprises repeat units derived from methylhydroquinone.

6. A method according to claim 1 wherein said product polycarbonate comprises repeat units derived from resorcinol and hydroquinone.

7. A method according to claim 1 wherein said product polycarbonate comprises repeat units derived from resorcinol, hydroquinone, and methylhydroquinone.

8. A method according to claim 1 wherein said product polycarbonate comprises repeat units derived from hydroquinone, and methyl hydroquinone.

Therefore, as is clear the same invention has been presently claimed because hydroquinone units have been disclosed in the reference. The term “ comprising” allows other components to be added.

Hydroquinone prepared by different process does not distinguish the polycarbonate as claimed.

Response to Remarks

Claim Rejections - 35 USC § 112

Rejection of claims 32, 33, 35 and 36 rejected under 35 U.S.C. 112, second paragraph, is withdrawn because claims are amended.

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35 USC § 112 --- First Paragraph Written Description Rejection

Rejection of claims 32, 33, 35 and 36 under under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is maintained on claim 32 and 35 for the same reasons as set forth in the previous office action. Claims 33 and 36 are canceled.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Qazi, Ph.D. whose telephone number is 571-272-0622. The examiner can normally be reached on any business day.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, Ph.D. can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SABIHA QAZI, PH.D
PRIMARY EXAMINER